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|--|-------------|----------------------|---------------------|------------------|
| 10/658,188 | 09/10/2003 | Tsung I. Yu | YUTS3011/EM | 3225 |
| 23364 | 7590 | 12/10/2004 | EXAMINER | |
| BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314 | | | ALTER, ALYSSA M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3762 | |

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 10/658,188 | YU, TSUNG I. | |
| Examiner | Art Unit | | |
| Alyssa M Alter | 3762 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09/10/03.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-14 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09/10/03 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-10, 12 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claiming of structures being in contact with or implanted within the body amounts to an inferential recitation of the body, which renders these claims non-statutory. The examiner recommends changing "in directly contact" in claim 1 to --adapted to be in direct contact with-- and "direct contact" in claim 2 to --adapted to be in direct contact with--

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-10, 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "effect of medium and low frequency" in claim 1 is a relative term which renders the claim indefinite. The term "medium and low frequency" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

2. Claims 2, 8 and 9 recites the limitation "an outer layer" in claims 2, 8 and 9 and "an inner cloth layer" in claim 8. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether the applicant intends to claim the layers. It is suggested to first positively recite the layers before it is used.

3. Claim 5 recites the limitation "said pulsed high voltage generated" in the second line of claim 5. There is insufficient antecedent basis for this limitation in the claim.

4. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms in claims 6 and 7, "is installed" and "each installed" respectfully, are vague and sound more like a method step rather than a structural limitation.

5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the applicant means the second end of the conductive strip is connected to more than one conductive plates in addition to a conductive button, or if the applicant intended to claim first end of the conductive strip.

6. Claim 13 recites the limitation "said conductive strips" in the second line of claim 13. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3762

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-2, 6, 8-10, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maida (US 6,151,528) in view of Krafft (US 5,050,595), Wyss et al. (US 4,148,321) and Post et al. (US 6,210,771). Maida discloses the claimed invention using low and medium frequencies.

In the alternative, Maida does not disclose a bra with pockets, the low and medium frequencies and the conductive buttons. Krafft teaches that it is known to use a bra with pockets for therapeutic treatment of the breasts, as set forth in column 1, lines 39-52. Wyss et al. teaches that it is known to use low and medium frequency during muscle massage, as set forth at column 2, lines 7-19. Post et al. teaches that it is known to substitute fasteners of known functional equivalents as set forth at column 2, lines 42-46.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the garment, the pulse-current generator and the clips and as taught by Maida with a bra that has pockets for the treatment means, a low and medium frequency generator and conductive buttons, as taught by Krafft, Wyss et al. and Post et al., respectively, in order to treat the upper part of the body, specifically the breasts, reduce pain during the massaging of muscles and make the generator removable in order to wash the garment.

As to claim 2, Maida discloses in col. 3, lines 25-28 "at the conductive portions 13, 14, 15 there are electrical contact means or strips 17, 18, 19 respectively each provided with a sticky surface for steady application or sewn".

As to claim 6, Maida discloses a "generator 12 comprises a device 24 (e.g. a switch) for selection of the connections of the generator outputs to the three electrically conductive poles 13, 14, 15"(col.4, lines 46-48).

2. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Maida as applied to claims 1-2, 6, 8-10, 12 and 14 above. The modified Maida discloses the claimed invention with the hertz range in col. 4, lines 30-38 but fails to teach the I/C circuit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the generator as taught by Maida with an I/C circuit since it was known in the art that therapy systems use I/C circuits to provide a smaller inexpensive circuit with reduced capacitance.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Maida as applied to claims 1-2, 6, 8-10, 12 and 14 above. The modified Maida discloses the claimed invention but does not disclose expressly the two control buttons. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the adjustable control unit as taught by the modified Maida with two buttons, because Applicant has not disclosed the two buttons provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected the Applicant's invention to perform equally well with the switch and a knob as taught by Krafft, because both can modify the stimulation parameters.

Therefore, it would have been an obvious matter of design choice to modify the adjustable control unit to obtain the invention as specified in the claim(s).

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Maida as applied to claims 1-2, 6, 8-10, 12 and 14 above. The modified Maida discloses the claimed invention but fails to teach a conductive strip connected with more than one conductive plates. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify one conductive plate in the modified Maida to more than one conductive plate, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

5. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al. (US 6,453,203) in view of Kalmis (US 5,690,537). Yamazaki et al. discloses the claimed invention except for a plate having a plurality of connective buttons to be inserted into a bra. Kalmus teaches that it is known to use a bra and insert electrically conductive material with a plurality of connectors on at least one plate as set forth in Figure 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tights as taught by Yamazaki et al. with the bra as taught by Kalmus, in order to treat the chest area, specifically the breasts and to ensure sufficient connection with a plurality of connectors attached to at least one conductive plate.

As to claim 13, since the claim lacks antecedent basis, the examiner considers the conductive strips to be the conductive plates, or the flat electrodes, which Yamazaki et al. discloses as having "aluminum foils applied to the narrow or four-sided pieces of

Art Unit: 3762

rubber or cloth in column 1, lines 30-31. Therefore the electrodes are obviously made of electrically conductive cloth.

Specification

1. The disclosure is objected to because of the following informalities: There is no mention of Figures 17. Appropriate correction is required.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 21 is mentioned on page 7, line 23 but not depicted in Figure 19. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 31 in Figure 19. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the

Art Unit: 3762

description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M Alter whose telephone number is (571) 272-4939. The examiner can normally be reached on M-F 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alyssa M. Alter

Alyssa M Alter
Examiner
Art Unit 3762

AMA

GEORGE R. EVANISKO
GEORGE R. EVANISKO
PRIMARY EXAMINER

12/04